

**Notice of Allowability**

Application No.

10/825,881

Examiner

Brian J. Davis

Applicant(s)

SCANLAN ET AL.

Art Unit

1621

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to applicant's AF amendment (5/21/07).
2. ☒ The allowed claim(s) is/are 1-13,22,23,25-33,36-40,43-47,59 and 60 [renumbered 1-36].
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application                      |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date <u>5/21/07</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment                               |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                  | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|   | 9. <input type="checkbox"/> Other _____.   |

## DETAILED ACTION

### Election/Restriction Rejoinder

Claims 1-13, 22, 59 and 60 are directed to an allowable product (i.e. a compound of formula (I) or composition which contains it). Pursuant to the procedures set forth in MPEP § 821.04(B), claims 23, 25-33, 36-40 and 43-47, directed to the process of making or using an allowable product, previously withdrawn from consideration as a result of a restriction requirement, are hereby rejoined and have been fully examined for patentability under 37 CFR 1.104. (See previous Office Action and the 4/13/07 Interview Summary.) Claims 14-21, 24, 34, 35, 41, 42 and 48-58 have been canceled by applicant's amendment.

Because some claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, **the restriction requirement with respect to Groups I and II when they are drawn to compounds of formula (I) as set forth in the Office action mailed on 1/4/06 is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

***Claim Objections Withdrawn***

The objection to claim 1, outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment corrects the claim text as appropriate.

***102 Rejections Withdrawn***

The rejection of claims 14-22, 46 and 47, in so far as they read on the species defined in the previous Office Action under 35 USC 102(b), has been overcome by applicant's amendment. Claims 14-21 have been canceled. Claims 22, 46 and 47 have been amended such that they now only depend from allowable claim 1.

***Allowable Subject Matter***

Claims 1-13, 22, 23, 25-33, 36-40, 43-47, 59 and 60 are allowed. The following is an examiner's statement of reasons for allowance:

As noted in the previous Office Action and the 4/13/07 Interview Summary, the set of compounds defined by formula (I) has been searched and deemed free of the prior art.

The closest prior art remains the prior art of record. During the course of prosecution, applicant has narrowed the claims such that they no longer read on the cited prior art. In the After Final amendment applicant has narrowed the claim set such

that all claims are now directed to compounds, compositions or methods of use of the allowable set of compounds of formula (I).

The prior art neither teaches nor suggests the instant compounds, compositions or methods. Nor would it have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of the prior art in order to arrive at those of the instant invention. There is no motivation to do so.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached at 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**BRIAN DAVIS**  
**PRIMARY EXAMINER**  
Brian J. Davis  
May 26, 2007